



Paper No. 9

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OFFICE OF PETITIONS

In re Application of	:	
Denz, Natchu & Blake	:	
Application No.: 10/028,473	:	DECISION REFUSING STATUS
Filed: December 28, 2001	:	UNDER 37 CFR 1.47(a)
Attorney Docket No.: P12692-US2/50001.2070	:	
For: METHODS AND SYSTEM FOR DATA	:	
PACKET FILTERING USING TREE-LIKE	:	
HIERARCHY	:	

This is a decision on the petition under 37 CFR 1.47(a), filed July 28, 2002.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on December 28, 2001 without an executed oath or declaration. Accordingly, on January 28, 2002, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring, *inter alia*, an executed oath or declaration and a surcharge for its late filing.

In response, on July 28, 2002, a declaration executed by joint inventors Denz and Blake and Attorney William D. Kolb on behalf of a company with proprietary interest in the invention, the surcharge, a four month extension of time with required fee, and the instant petition and required fee were filed. A declaration of facts of Mary Bensele accompanied the petition. Mary Bensele states that despite numerous attempts to contact Mr. Natchu through telephone, e-mail, and mailings, that Mr. Natchu refuses to sign the declaration for the above-identified application.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks item (2) above.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration submitted with the instant petition was signed by two of the inventors. Attorney Kolb signed an addendum to the declaration on behalf of a company with proprietary interest.

It appears that petitioners have submitted documents with the intention of having an entity with a proprietary interest intervene and make the application on behalf of the non-signing inventor. Petitioners are reminded that when at least one joint inventor signs, the provisions of 37 CFR 1.47(a) apply. Where 37 CFR 1.47(a) is available, application cannot be made under 37 CFR 1.47(b). MPEP 409.03(b)

In this instance, inventors Denz and Blake signed the declaration. Therefore, the declaration with Attorney Kolb's signature is not acceptable.

Messrs. Denz and Blake must execute another declaration that contains information for Mr. Natchu. The declaration in the application file only lists his name. His citizenship,¹ his residence, his post office address must be included. As stated in MPEP 605.03, "In situations where an inventor does not execute the oath or declaration and the inventor is not deceased, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary."

The signing inventors must sign another declaration for the application on behalf of themselves and on behalf of the non-signing inventor. The declaration will be acceptable if the signing inventors sign in their respective signature block and (1) the signature block of the non-signing inventor is left blank **OR** (2) the signing inventors sign a document that states they are signing on behalf of the non-signing inventor, as well. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47(a) applicant on behalf of Mr. Natchu is **REQUIRED**. See MPEP 409.03(a).

Pursuant to petitioners' authorization, deposit account no. 50-0530 will be charged the \$130.00 fee associated with filing a Rule 47 petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

¹ As listing the citizenship for each inventor is a statutory requirement under 35 USC 115, it cannot be waived

Telephone inquiries should be directed to the undersigned at (703) 308-6712.

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